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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,499	08/05/2003	Martin Grohman	33105	8662
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HOVEY WILLIAMS LLP				
Suite 400				
2405 Grand Boulevard				
Kansas City, MO 64108				
		EXAMINER		
		SLACK, NAKO N		
		ART UNIT		
		PAPER NUMBER		
		3635		

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,499

Applicant(s)

GROHMAN, MARTIN

Examiner

Naoko Slack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/04, 7/04, 2/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of applicant's Preliminary amendment received November 12, 2004, claims 1-27 have been canceled as requested, claim 28 amended, and new claims 31-60 entered. The IDSs dated 1/30/04, 7/19/04, and 2/2/05 have been entered and considered.

Specification

On page 1, paragraph 1 of the specification purports to claim priority benefit from another US Application; however, both applications have the same filing date. Therefore, there is no priority benefit. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28-33, 36-38, and 40-60 are rejected under 35 USC 102(e) as being clearly anticipated by US Patent 6,314,699B1 to West.

Claim 28:

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West discloses a deck system comprising: a plurality of laterally spaced joists (14, Figure 1); a plurality of boards (16, Figure 1) extending across and supported by the joists, each of said boards presenting an upper lip (74, Figure 6) and a lower lip (84, Figure 6), said upper and lower lips defining a pair of longitudinally extending grooves on generally opposite sides of the board, and said lower lip having a thickness "E"; and a plurality of fasteners (12, Figure 1A) rigidly coupled to the joists, each of said fasteners presenting a pair of protrusions having a height "F" each of said protrusions being received in a respective groove of a respective board in a substantially complementary fashion, wherein "E" is at least 1% greater than "F." Figure 1A clearly shows that "E", the lower lip thickness, is at least 1% greater than "F", the protrusion height.

Claims 29 and 30:

As best shown in Figure 1A, "E" is at least 5% greater than "F".

Claim 31:

West's protrusions exert a downward holding force on the lower lips when the protrusions are at least partially received within the grooves, by way of a nub (48) which is lower than the lower lip height.

Claim 32:

The downward holding force is due to the thickness of the lower lips being at least 1% greater than the height of the protrusions, as stated above.

Claim 33:

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The downward holding force inhibits upward movement of the boards relative to the fasteners and joists (column 1, lines 56-60).

Claim 36:

West's fasteners securely couple the boards to the joists when the protrusions are at least partially received within the grooves (column 1, lines 56-60).

Claim 37:

West's deck system comprises a plurality of laterally spaced joists (14, Figure 1); a first board (16, Figure 1) extending across and supported by the joists, the first board presenting a pair of similarly configured opposite sides (Figure 6), each of the sides including a pair of spaced-apart longitudinally extending lips presenting opposing inwardly facing surfaces; and a fastener (12, Figure 1A) rigidly coupled to at least one of the joists, the fastener presenting at least one protrusion (48), the protrusion being operable to contact both of the inwardly facing surfaces on one of the sides of the first board to continually exert a first holding force on one of the lips to force the first board towards the joist.

Claim 38:

The first holding force more securely couples the first board to the joist than if no first holding force is applied.

Claim 40:

The first holding force inhibits upward movement of the first board relative to the fastener and joists (column 1, lines 56-60).

Claims 41-43:

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As best shown in Figure 1A, the thickness of the lip upon which the first holding force is exerted is at least 5% greater than the height of the protrusion relative to the joist when the protrusion is not flexed.

Claim 44:

The first holding force securely couples the first board to the joists (column 1, lines 56-60).

Claim 45:

West's deck system includes a second board (16, Figure 1), the second board being substantially similar to the first board, wherein the fastener exerts a second holding force on the second board such that the first holding force and the second holding force inhibit movement of the first board and second board relative to the joists thereby forming a more rigid deck system than if the holding forces were not present.

Claim 46:

West discloses a method of coupling a plurality of boards to a plurality of support members, the method comprising the steps of: (a) rigidly attaching a first fastener to a first support member (column 2, lines 58-65), the first fastener having at least one protrusion (48); (b) positioning a first board across the first support member and against the rigidly-attached first fastener such that the protrusion of the first fastener is at least partially received in a first longitudinal groove of the first board to form a mating relationship between the first board and the first fastener, wherein the positioning of the first board and the first fastener in the mating relationship causes the protrusion of the first fastener to flex and exert a first holding force on the first board (column 2, line 66-

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column 3, line 14 and column 4, lines 50-55); (c) positioning a second fastener against the first board such that a protrusion of the second fastener is at least partially received in a second longitudinal groove of the first board to form a mating relationship between the first board and the second fastener; and (d) rigidly attaching the second fastener to the first support member while maintaining the mating relationship between the first board and the first and second fasteners.

Claim 47:

The first holding force inhibits movement of the first board relative to the first fastener and the first support member.

Claim 48:

The first holding force holds the first board against the first support member (column 1, lines 56-60).

Claim 49:

Rigidly attaching the second fastener to the first support member causes the protrusion of the second fastener to flex and exert a second holding force on the first board, as the secure contact between the fastener and board causes flexure in response to the force acting there between (column 1, lines 56-60 and column 4, lines 50-59).

Claim 50:

Clearly when fasteners are attached to opposite sides of a deck board, the first and second holding forces are exerted on generally opposite sides of the first board.

Claim 51:

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The first and second holding forces hold the first board against the first support member (column 1, lines 56-60).

Claim 52:

The first and second holding forces securely couple the first board to the first support member (column 1, lines 56-60).

Claim 53:

The longitudinal grooves are generally defined by an upper lip (74, Figure 6) and a lower lip (84, Figure 6) and the first holding force is exerted against the lower lip (column 4, lines 50-55).

Claims 54-56:

As best shown in Figure 1A, the thickness of the lower lip is at least 5% greater than the height of the protrusions relative to the support members when the protrusions are not flexed.

Claims 57 and 58:

A second board is positioned across the first support member and against the second fastener to thereby form a mating relationship between the second board and the second fastener, the second fastener is disposed generally between the first and second boards (column 2, lines 44-47).

Claim 58:

A second fastener causes a gap (24) to be maintained between the first and second boards.

Claim 60:

The holding force inhibits movement of the boards relative to one another, movement of the support members relative to one another, and movement of the boards relative to the support members, thereby forming a more rigid deck system than if the holding force were not present (column 1, lines 56-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 35, and 39 are rejected under 35 USC 103(a) as being unpatentable over US Patent 6,314,699B1 to West.

Claims 34, 35, and 39:

While West does not specify that the fasteners comprise resilient material such as PVC, resilient fasteners are well known in the decking industry. For example, Erwin et al. discloses a decking system comprising grooved deck boards attached to an underlying support using deck fasteners made of PVC (column 3, lines 51-52). In view of Erwin et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to form West's fasteners of resilient material such as PVC to facilitate insertion of the connector's protrusions into the grooves, as Erwin et al. states that the T-connectors are shaped and sized to conform to and fit within the grooves (column 3, lines 46-47).

Prior Art

US Patent 5,660,016A to Erwin et al. discloses decking boards with similar sides, each side comprising a groove formed by a top lip which extends further than the underlying lower lip. US Patent 6,711,864B2 to Erwin discloses deck boards with grooved sides that engage PVC fasteners. Other references disclosing grooved panels connected by fasteners includes:

US Patent 4,599,841 to Haid,

US Patent 5,941,040 to McAnallen et al.,

US Patent 5,355,648A to Graver et al.,

US Patent 5,123,225A to Goodworth, and

US Patent 4,169,340 to Watson.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (571) 272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naoko Slack
Primary Examiner
Art Unit 3635

NS
September 16, 2005